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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9314-57

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on September 22, 2006

Signature

Typed or printed name Betty-Lou Rosser

Application Number

10/736,079

Filed

12/15/2003

First Named Inventor

Lee Hill

Art Unit

2688

Examiner

Emem Ekong

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number

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September 22, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

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Attorney Docket No. 9314-57

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Hill et al.

Examiner: Emem Ekong

Serial No.: 10/736,079

Group Art Unit: 2688

Filed: December 15, 2003

Confirmation No: 3249

For: **METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR CONTROLLING USAGE OF A MOBILE TERMINAL**

September 22, 2006

Mail Stop AF
Commissioner for Patents
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Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal. Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed July 13, 2006 (hereinafter "Final Action").

No fee or extension of time is believed due for this request other than those submitted with the petition for extension of time filed concurrently herewith. However, if any further fee or extension of time for this request is required, Applicant requests that this be considered a petition therefor. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Claims 1-32 are pending in this application. Claims 1, 2, 9-13, 15, 16, 18, 19 and 22-24 have been rejected under 35 USC §103(a) as being obvious over U.S. Patent No. 5,884,193 to Kaplan (hereinafter "Kaplan") in view of U.S. Patent No. 5,517,554 to Mitchell et al. (hereinafter "Mitchell"). Final Action, Page 4. Applicants respectfully submit that these rejections are based on a clear error in understanding the applied references, and that the Final Office Action has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will only discuss the

particular clear errors made in the rejections of the independent Claims 1 and 22 that establishes that the rejections of these claims are improper.

Independent Claim 1 includes recitations related to limiting usage of a mobile terminal based on a received usage specification. For example, Claim 1 recites:

1. A method for controlling usage of a mobile terminal, the method comprising:
 - receiving a usage specification including an identification of allowed numbers, an identification of restricted numbers, a usage time limitation, an expiration value and/or a specification of enabled services of the mobile terminal that are restricted; and
 - limiting usage of the mobile terminal based on the received usage specification responsive to receipt of a valid authorization code; and
 - wherein receiving a usage specification and limiting usage further comprise at least one of the following:
 - receiving a usage specification restricting access to enabled services of the mobile terminal including internet access services, multimedia messaging access services, email services, camera and/or video functions; and/or
 - receiving the authorization code wherein the authorization code is encoded to restrict viewing of the authorization code by a user of the mobile terminal. (*Emphasis added*).

Applicants submit that at least the highlighted portions of Claim 1 are not disclosed or suggested by the combination of Kaplan and Mitchell.

The Final Action asserts, among other things, that Kaplan discloses receiving a usage specification restricting access to enabled services of the mobile terminal. *See* Final Action, Page 4. More particularly, the Final Action argues that Kaplan teaches a system that can be implemented in personal communication system (PCS) devices and wireless local loop (WLL) telephones, and that "it is inherent, that the PCS, and WLL devices are used for email and internet services". Final Action, Page 4.

Although the system 100 of Kaplan may be implemented in devices used for email and internet services, Applicants submit that Kaplan does not disclose or suggest *restricting access* to such services. *See* Kaplan, Col. 3, lines 38-42. Rather, Kaplan describes providing "various levels of call restriction that can be selected by the user". Kaplan, Col. 3, lines 31-34 (*emphasis added*). Such call restrictions include, for example, restrictions on domestic and/or international long distance calls, 411 numbers, 800 numbers, 900 numbers, collect calls, call waiting, call forwarding, speed dialing, and the like. *See* Kaplan, Col. 7, lines 44-

66. As such, the Final Action inaccurately characterizes the disclosure of Kaplan as teaching restricting access to "internet access services, multimedia messaging access services, email services, camera and/or video functions", as recited by Claim 1. This mischaracterization illustrates a clear factual error underlying the rejection of Claim 1.

The Final Action further asserts that Mitchell discloses receiving an authorization code that is encoded to restrict viewing of the authorization code by a user of the mobile terminal. *See* Final Action, Page 4. In particular, the cited portion of Mitchell states that "it is known to scramble or otherwise encrypt the [mobile identification number] MIN and [electronic serial number] ESN during broadcast". Mitchell, Col. 1, lines 57-59. As such, the Final Action argues that the MIN and ESN are encoded authorization codes. *See* Final Action, Page 2.

Applicants submit that the MIN and the ESN of Mitchell are not authorization codes, but rather, are used for identification purposes. For example, Mitchell states that "the mobile communication unit is assigned a mobile identification number (MIN) and electronic serial number (ESN) which are used to identify the mobile communication unit when it operates within the cellular communication system...the mobile communication unit is required to broadcast, over the air, the MIN and the ESN...so that calls placed or received by the mobile communication unit may be properly identified and billed." Mitchell, Col. 1, lines 14-35 (*emphasis added*). Accordingly, the MIN and/or ESN are broadcast from the mobile terminal for *identification* of the mobile terminal by a cellular system (for example, for billing purposes), not for *authorization* of the mobile terminal.

The Final Action further argues that the MIN is an authorization code because the MIN is used to access a mobile switching center (MSC). *See* Final Action, Page 2. However, the cited portion of Mitchell provides:

In accordance with a preferred embodiment of the present invention, the mobile user can lock the MIN assigned to a mobile communication unit **22** at the MSC **18** by directly accessing the MSC **18**...the user is allowed access to MSC **18** by first dialing an access number **100**. The MSC **18** receives the access code number **102** and responds with a dial tone **104**. The user receives the dial tone **106** and responds by keying in the MIN and the PIN **108**. The MSC **18** receives the MIN and PIN **110** and verifies, based on the information stored in its memory, that the MIN and associated PIN are correct **112**. If the MIN and PIN are correct, a dial tone is once again provided to the user **114**. The user receives the dial tone **116** and responds by entering an activation/deactivation code **118**. That is, if the MIN is presently locked, the

user will enter a deactivation code to unlock the MIN, and vice versa if the MIN is unlocked, the user will enter an activation code to lock the MIN...Access to the MSC 18 is then terminated 126.

Mitchell, Col. 3, lines 22-45. In other words, the user accesses the MSC 18 by dialing an access number, and then keys in the MIN along with an activation/deactivation code to lock/unlock the MIN. As such, the user does not use the MIN as an authorization code to access the MSC 18, but rather, accesses the MSC 18 to control use of the MIN. Accordingly, the Applicants submit that the Final Action inaccurately characterizes the identification numbers described in the disclosure of Mitchell as the "authorization code" recited by Claim 1, which illustrates a clear error in understanding the applied reference.

The Final Action also argues that Mitchell discloses that the MIN is encoded to restrict viewing by a user of the mobile terminal. *See* Final Action, Page 2. However, as noted above, Mitchell describes scrambling and/or encrypting of the MIN and/or ESN *during broadcast*. *See* Mitchell, Col. 1, lines 57-59. In addition, Mitchell states that "[c]ellular pirates, fraudulent users of the cellular communication system, have developed methods of intercepting the MIN and ESN numbers during such broadcasts...[t]he cellular pirates have also developed methods of programming 'clone' mobile communication units with the intercepted MIN and ESN numbers.". Mitchell, Col. 1, lines 36-42. As such, the MIN and/or ESN of Mitchell appear to be encoded to restrict viewing thereof *by cellular pirates* and/or other unauthorized parties, not *by a user* of the mobile terminal. The Final Action further argues that "the cellular pirate can be the user". *See* Final Action, Page 2. However, as a user, a cellular pirate would already have possession of the mobile terminal, and thus, would not need to intercept the MIN and ESN numbers during broadcast to program a clone mobile terminal. Thus, Applicants respectfully submit that the Final Action inaccurately characterizes the encrypted MIN and ESN in Mitchell as being encoded to restrict viewing "by a user of the mobile terminal", as recited by Claim 1.

The Final Action further asserts that it would be obvious to modify the invention of Kaplan based on the encrypted MIN of Mitchell "for the purpose of securing the device". *See* Final Action, Page 5. However, Applicants respectfully submit that one of skill in the art would not be motivated to combine the teachings of Mitchell with those of Kaplan, and that the references themselves provide no such suggestion or motivation. More particularly, as discussed above, Mitchell is directed to preventing a mobile communication unit from

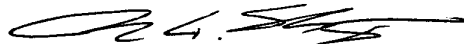
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accessing a cellular communication system by locking the MIN of the mobile communication unit at the mobile switching center (MSC). *See* Mitchell, Col. 2, lines 42-51. In contrast, Kaplan describes selectively restricting usage of particular calling functions within the mobile terminal itself. *See* Kaplan, Col. 3, lines 35-45. Accordingly, Applicants submit that one of skill in the art would not be motivated to combine operations performed *at a mobile switching center* for preventing *general* use of a mobile terminal (as described in Mitchell) with operations performed *at the mobile terminal* for restricting *specific* uses of the mobile terminal (as described in Kaplan). Moreover, the complete restriction of use of the mobile terminal described in Mitchell appears to teach away from the stated advantages of "various levels of call restriction" described in Kaplan. Kaplan, Col. 3, lines 31-34.

Applicants therefore submit that Kaplan and Mitchell fail to disclose or suggest at least the recitations of Claim 1 highlighted above, and that it would not be obvious to combine the teachings of Kaplan and Mitchell. For at least these reasons, Applicant submits that the Final Action has not provided a *prima facie* case for the obviousness of Claim 1 over the combination of Kaplan and Mitchell. Accordingly, the rejections of Claim 1 and the claims that depend therefrom should be reversed. Independent Claims 22 and 30 include recitations similar to Claim 1, and as such, the rejections of these claims and the claims that depend therefrom should also be reversed for substantially similar reasons.

Accordingly, with respect to all the pending rejections, it is a clear error of fact to assert that the combination of Kaplan and Mitchell discloses or suggests the recitations of Claims 1, 22, and 30. Therefore, Applicant respectfully requests that the present application be reviewed and the rejections of Claims 1-32 be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



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Betty Lou Rosser

Date of Signature: September 22, 2006